

### **AMENDMENTS TO THE DRAWINGS**

The attached sheets of drawings include changes to Figs. 60, 63 and 81 and replace original sheet 12/16 including Figs. 60-64 (see REPLACEMENT SHEET 1/2) and original sheet 15/16 including Figs. 81-86 (see REPLACEMENT SHEET 2/2).

Fig. 60 has been amended so that reference 265 now designates the top segment of the figure as well as the bottom segment of the figure. Further, reference 263 erroneously designating an opening of the bottom segment 265 has been replaced by reference 269.

Fig. 63 has been amended so that reference 263 designates clearly the sidewall of the bottom segment of the figure.

Fig. 81 has been amended so that both references 411 of fig. 81 indicate a hole in support 409 in the top and bottom parts of fig. 81.

Also enclosed are marked-up copies of original sheets 12/16 and 15/16, showing the amendments made.

### **REMARKS**

Claims 131-147 are pending in the application.

#### **Amendments to the claims**

Claims 131, 134-137, 139, 142, 145 and 146 have been amended. No new matter has been added.

#### **Section 3 of the Action (Priority)**

The present Application is the U.S. National Stage of PCT-US00/18389. In the Action, the Examiner makes reference to the cover page of WO/13754-A1 (publication of PCT-US00/18389), to assert that PCT-US00/18389 does not claim priority to U.S. App. S/N 09/224,936, because such front page does not mention U.S. App. S/N 09/224,936. The Applicants respectfully disagree.

The Applicants submit that the filing stage of the PCT-US00/18389 application has been prepared with the software PCT-EASY, which provides for a field (field 63) for entering a single relation by Continuation-in-part or by Continuation. However, Applicants have filed the PCT application with more than a single relation. The fact that Field 63 in the front page of WO/13754-A1 only shows one relation by CIP to 09/383,814 does not mean that PCT-US00/18389 is not also a continuation-in-part of U.S. App. S/N 09/224,936.

For ease of reference of the Examiner, the Applicants enclose the first page of the specification of the publication of PCT-US00/18389, which clearly states (line 3) that PCT-US00/18389 is also a continuation-in-part of U.S. 09/224,936. The Applicants also enclose a copy of the application form of PCT-US00/18389 as filed. The Examiner's attention is drawn, in particular, to section 13-1-1 of the form (see last page) where the relationship between the present application and U.S. 09/224,936 is clearly shown.

Therefore, PCT-US00/18389 is a continuation in part of U.S. application 09/224,936. As a consequence, the present application 10/070,037 is also a continuation-in-part of U.S. 09/224,936. Therefore, Applicants submit that the priority claim is correct.

**Section 4 of the Action (Oath/Declaration)**

In the Action, the Examiner submits that the oath or declaration is defective. In particular, the Examiner states that the oath or declaration is defective because it claims priority to an application (App. S/N 09/224,936) from which a valid priority cannot be claimed. However, the Applicants have already shown above that the priority claim to App. S/N 09/224,936 is valid. Therefore, the Applicants submit that the oath or declaration is not defective and no new oath or declaration is necessary.

**Section 5 of the Action (Drawings objections)**

In the Action, the drawings are objected to as failing to comply with 37 CFR 1.84 (p)(4). In particular, the Examiner states that "reference character "263" has been used to designate both sidewall, segment, and what appear to be an opening (Figs 60-61)". Page 33 of the specification and figures 60-61 have been amended so that reference 263 now only refers to the sidewall. The Applicants therefore respectfully request the Examiner to withdraw her objection.

**Section 6 of the Office Action (Drawings objections)**

In the Action, the drawings are objected because in fig. 75, "364" is never identified. Page 39 of the specification has been amended so that reference 364 refers to the retainer, in conformity with the suggestion of the Examiner (see replacement sheet 1/2). The Applicants therefore respectfully request the Examiner to withdraw her objection.

**Section 7 of the Office Action (Drawings corrections)**

In the Action, the Examiner asks the Applicants to check about minor errors in the drawings. Accordingly, Fig. 81 has been amended so that both references 411 of fig. 81 indicate a hole in support 409 in the top and bottom parts of fig. 81 (see replacement sheet 2/2).

**Section 10 of the Office Action (Specification objections)**

In the Action, the Examiner states that the Applicants cannot incorporate by reference non-patent literature, or another application (U.S. App. S/N 09/383,814) that incorporates material by reference.

Concerning the incorporation by reference of non-patent literature (page 44, lines 13-17): page 44 has been amended to suppress the incorporation by reference of non-patent literature.

Concerning the incorporation by reference of U.S. App. S/N 09/383,814: PCT-US00/18389 claims priority of U.S. App. S/N 09/383,814, which is to be considered as "an application which is relied on to establish an earlier effective filing date", see *Ex Parte Maziere*, 27 USPQ2d 1705, 1706-07. The Applicants respectfully request the Examiner to withdraw her objection.

**Section 12 of the Office Action (specification objections)**

In the Action, the Examiner objects to the disclosure for informalities page 32, lines 5-12, 13-19 and 20-25; page 33, lines 12-20; page 38, line 3; page 23, line 23; page 34, line 23-24. The Examiner also objects to the term "plate-like" as being unclear and requests that the term "metal" be suppressed from page 42, lines 21-29.

Accordingly, the paragraphs between lines 5-25 of page 32 have been clarified. In figure 56, reference numerals 239 designate areas where pockets and alternatively bases are formed.

In figure 57, reference numeral 243 designates an area where a pocket and alternatively a base is formed. In figure 58, reference numerals 247 designate areas where pockets and alternatively bases are formed.

As described above with reference to section 5 of the Office Action, in page 33 reference numerals 263 now only refer to the sidewall.

Page 38 has been amended to replace the word "sis" by the word "is".

Page 23 has been amended to suppress the hyphen.

Page 34 has been amended to suppress the faded typing.

In pages 17, 36, 38, 40 and 41, the term "*plate-like*" has been replaced by the term "*plate-shaped*". Page 37, lines 5-9 recites that a member may have a plate, or strap, or tab fixed to prevent rotation of the decorative object. The Applicants submit that this sentence does not equate the structures of a plate to a strap or a tab, but merely submits that a plate or a strap or a tab may be used for a same purpose, i.e. to prevent the rotation of an object.

Page 42 has been amended to delete the word "*(metal)*".

The Applicants respectfully request the Examiner to withdraw her objection.

### **Section 13 of the Office Action (Claim objections)**

Claims 134-137 and 142 have been amended to replace the feature "*plate-like*" with the feature "*plate shaped*". The Applicants submit that the wording "*plate shaped*" is self explanatory.

In claim 137, the word "*top*" has been replaced by "*base member top*".

### **Section 14 of the Office Action**

In Claim 131, the words "*configured and sized in relation to said base member top opening to be inserted, through said top opening, into said hollow interior and entirely positioned below said top*" have been replaced by the words "*smaller than said opening, said decorative insert for being inserted, through said opening, into said hollow interior and positioned entirely below said top*".

In Claim 139, the words *"configured and sized in relation to said base member to be inserted through said top opening and into said hollow interior"* have been replaced by the words *"smaller than said opening, said decorative insert for being inserted, through said opening, into said hollow interior and positioned entirely below said top"*.

In Claim 145, the words *"configured and sized in relation to said base segment top opening to be inserted, through said top opening, into said hollow interior and positioned below said top"* have been replaced by the words *"being smaller than said opening, each decorative insert for being inserted, through said opening, into said hollow interior and positioned entirely below said top"*.

In Claim 146, the words *"configured and sized in relation to the top opening to be inserted, through the top opening, into the hollow interior and entirely positioned below the top"* have been replaced by the words *"smaller than said opening, said plate-shaped insert for being inserted, through said opening, into said hollow interior and positioned entirely below said top"*.

Claims 131, 139, 145 and 146 are rejected under 35 U.S.C. 102(b) as being anticipated by Taylor (U.S. 5651274). The Applicants respectfully disagree.

Taylor describes a decorative insert larger than the opening of a member base top. This is clearly taught by the figures of Taylor and has been noticed by the Examiner at page 10 of the Office Action (in connection with claims 133 and 134), where the Examiner acknowledges that "the decorative insert photograph 9 is inherently (emphasis added) bent and/or swaged when inserted". Should Taylor disclose a decorative insert smaller than the opening in the member top of claim 131, the decorative insert would not have to be bent. Therefore, it is believed that Taylor does not anticipate the *"decorative insert smaller than said opening in said base member top, permitting said decorative insert to be inserted, through said opening, into said hollow interior and positioned entirely below said top"* of claims 131, 139, 145 and 146.

Claims 132, 133, 136 depend directly or indirectly on claim 131 and claims 140, 141

depend on claim 139. Claims 132, 133, 136, 140 and 141 are not anticipated by Taylor by virtue of the above dependency.

#### **Section 16 of the Office Action**

Claims 134, 135, 137 and 142 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor in view of Fitzgerald (U.S. Pat. No. 901,333). The Applicants respectfully disagree.

The Applicants have shown above that Taylor does not disclose a decorative insert "*smaller than said opening in said base member top, permitting said decorative insert to be inserted, through said opening, into said hollow interior and positioned entirely below said top*" as recited in claims 131, 139, 145 and 146.

Fitzgerald discloses (column 4, lines 16-19) a signet plate "*of a shape to fit exactly within the flange or bezel 3 of the box or head*". Therefore, Fitzgerald does not teach or suggest a decorative insert "*smaller than said opening in said base member top*" of claims 131, 139, 145 or 146.

Fitzgerald further discloses (column 4, lines 22-26) a signet plate where "*the annular portion of the outer surface of the signet plate 22 lies flush, or in the same plane with the outer surface of the flange or bezel 3 of the box or head 2*". Fitzgerald does not teach or suggest the decorative insert "*permitting said decorative insert to be inserted, through said opening, into said hollow interior and positioned entirely below said top*" of claims 131, 139, 145 or 146.

Overall, neither Taylor nor Fitzgerald do disclose a decorative insert "*smaller than said opening in said base member top, permitting said decorative insert to be inserted, through said opening, into said hollow interior and positioned entirely below said top*" of claims 131, 139, 145 or 146. Therefore, the Applicants submit that a prima-facie 35 U.S.C. 103(a) case based on Taylor and Fitzgerald cannot be made against claims 131, 139, 145 or 146. Further, claims 134, 135, 137 depend indirectly on claim 131, while claim 142 depends indirectly on claim 139. Therefore, also claims 134, 135, 137 and 142 are patentable over Taylor in view of Fitzgerald, by virtue of their dependency on the above claims.

\* \* \*

The Applicants submit that all claims of the application as amended herein are in condition for allowance. Prompt issuance of a Notice of Allowance is earnestly solicited.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450 on

Respectfully submitted,



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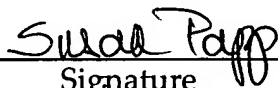
(323)934-2300

February 7, 2005

(Date of Deposit)

Susan Papp

(Name of Person Depositing)



Signature

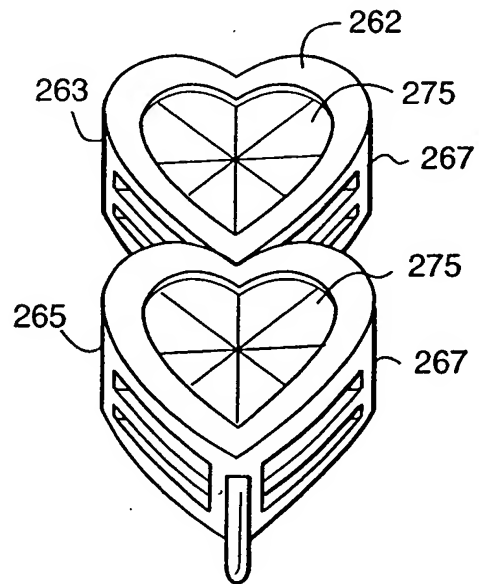
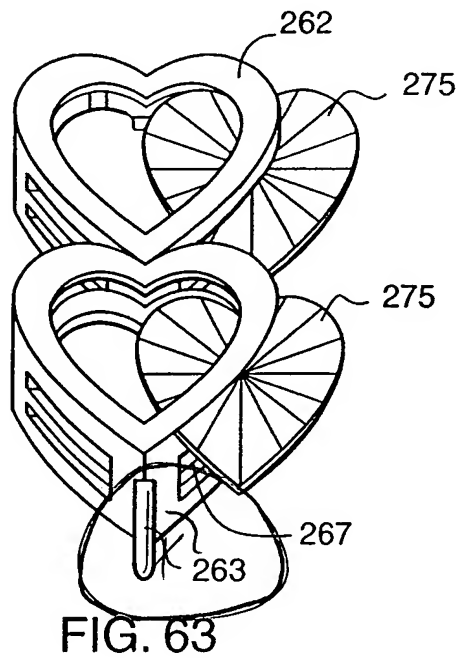
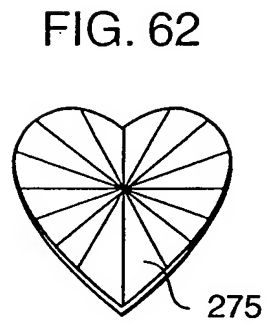
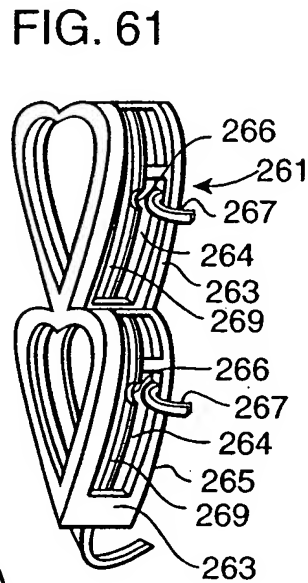
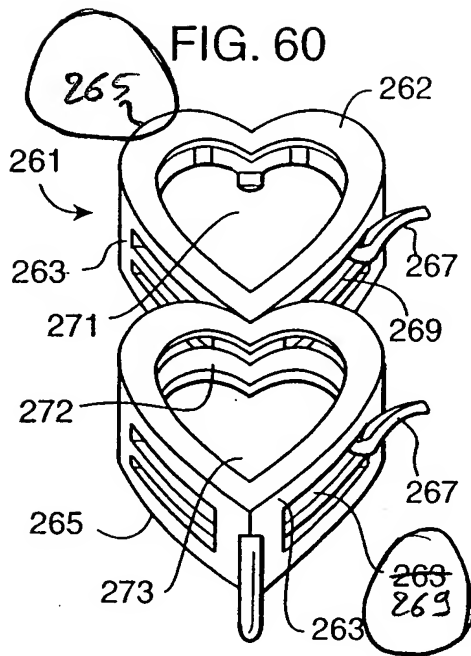
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Date

Enclosures:

- Replacement sheets 1/2, 2/2 and marked-up copies of pages 12/16 and 15/16 of the drawings
- Petition for 3-month extension of time
- Check for fee for 3-month extension in the amount of \$510.00
- Copy of cover page of PCT application
- Copy of PCT request
- Postcard





# ANNOTATED MARKED-UP DRAWINGS. 2/2

15/16

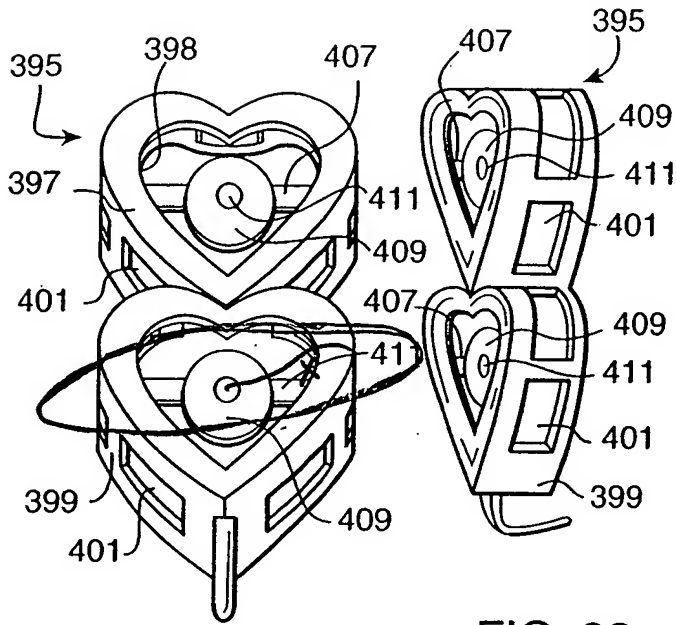


FIG. 81

FIG. 82

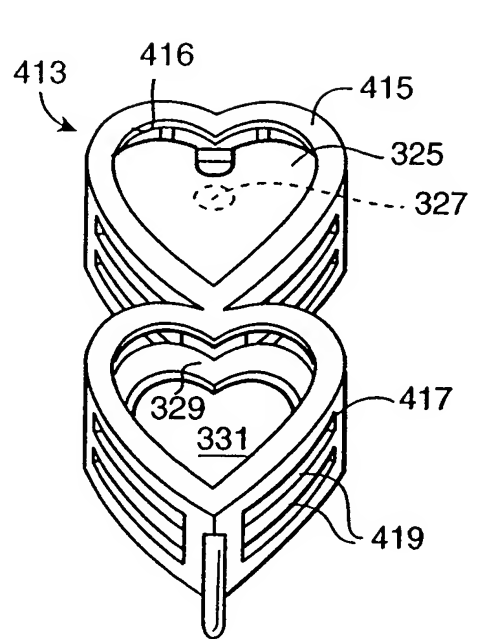


FIG. 83

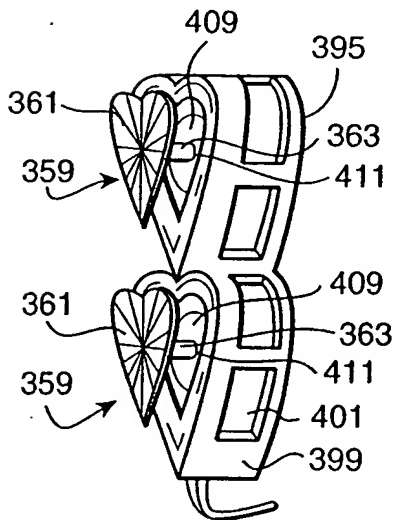


FIG. 84

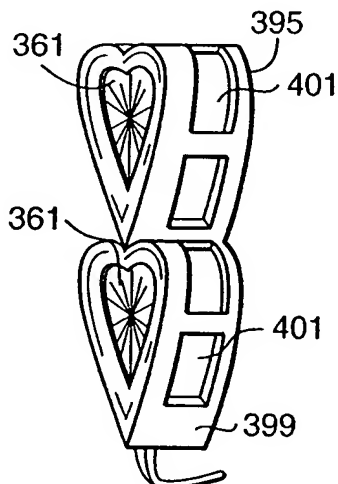


FIG. 85

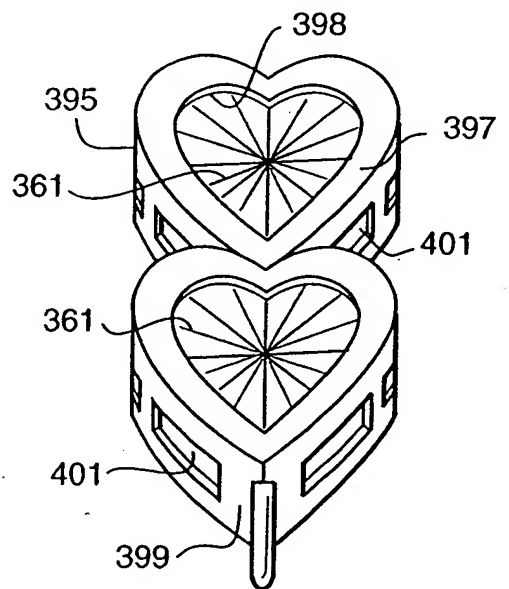


FIG. 86